

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* MANFRED A. MORGHEN

---

Appeal No. 98-0005  
Application No. 08/613,808<sup>1</sup>

---

ON BRIEF

---

Before MEISTER, ABRAMS and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-6, 10 and 11. Claims 7 and 8 have been canceled, claim 9 has been indicated as being allowable if rewritten in independent form, and claims 12-20 have been

---

<sup>1</sup>Application for patent filed March 6, 1996.

Appeal No. 98-0005  
Application No. 08/613,808

withdrawn from consideration as being directed to a nonelected invention.

The appellant's invention is directed to a work piece clamping system. The subject matter before us on appeal is illustrated by reference to claim 1, which has been reproduced in an appendix to the Appellant's Brief.

#### **THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Maley 1903	724,116	Mar. 31,
Woodman 1912	1,016,594	Feb. 6,
Andrew 1928	1,685,899	Oct. 2,
Cardner 1932	1,842,147	Jan. 19,
Boggs 1969	3,473,420	Oct. 21,
Allen 1991	5,046,707	Sep. 10,

#### **THE REJECTIONS**

Appeal No. 98-0005  
Application No. 08/613,808

Claims 1-5<sup>2</sup> stand rejected under 35 U.S.C. § 103 as being unpatentable over Maley in view of Allen, Woodman and Andrew.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Maley in view of Allen, Woodman, Andrew and Cardner.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maley in view of Allen, Woodman, Andrew and Boggs.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

#### **OPINION**

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the

---

<sup>2</sup>Canceled claim 7 erroneously has been listed as being on appeal.

art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). The appellant's invention is directed to clamping a work piece in place tightly pressed against the surface of a base plate. Among the structural limitations set forth in claim 1, the sole independent claim, is an arm having a cam surface with a varying diameter around the pivot pin upon which the arm is mounted,

said cam surface having a plurality of angled grooves for engaging said work piece and forcing said work piece toward said base plate, pins and other clamps as said cam surface is pivoted into pressure engagement with said work piece.

The examiner points out that the basic structure of the claimed clamping system is disclosed by Maley, except for several features, including the angled grooves limitation quoted above. It is the examiner's position, however, that such angled grooves are taught by Andrew, and it would have been obvious to one of ordinary skill in the art to so modify the Maley structure in this manner. We do not agree.

While Maley teaches securing a work piece to a base plate in a manner that presses it against the surface of the base plate, it does so in a manner quite different from the claimed system. Whereas the claim calls for a pivot pin mounted on a support block and an arm having a cam surface mounted on the support block for pivoting movement about the pivot, in Maley the pivot pin (e) protrudes through the support block (f), but is mounted on the base plate (a). It then follows that the arm in the Maley device also is not mounted on the support block, as is recited in the appellant's claims. Claim 1 also requires that the cam surface that presses the work piece into contact with the base plate be mounted on the arm, but in Maley it is mounted on the support plate. Therefore, the cam surface does not act directly upon the work piece, and there

would be no reason to add a plurality of angled grooves to its surface. Nor, for that matter, would there be a reason to add such grooves to Maley's cam surface ( $f^2$ ), since it does not rotate in contact with the work piece, but simply acts upon an inclined surface provided on the edge of the work piece. In our opinion, the rejection fails at this point.

Adding Andrew to the primary reference does not alleviate this problem. Andrew discloses a work piece clamping device which in one embodiment presses the work piece against the base plate, and in the other does not. In the embodiment shown in Figure 2, circular teeth (19), which are not angled as are screw threads, engage the edge of the work piece. Rotating the screw (14) causes it to displace downwardly by action of the screw threads (15), thus pressing the work piece against the base plate; however, there are no angled grooves on the portion that engages the edge of the work piece in this embodiment. Angled threads (28) are in contact with the edge of the work piece in the version shown in Figure 3. However, they are matching but oppositely oriented to screw threads (25) of the rotating member (26), so that when the latter is

rotated, the work piece will not be pressed against the base plate (page 2, lines 102-112).

We fail to perceive any teaching, suggestion or incentive in either Maley or Andrew which would have led one of ordinary skill in the art to modify the Maley apparatus in the manner proposed by the examiner. To follow the teachings of Andrew's first embodiment would lead the artisan to place parallel teeth on a cam surface and press the work piece into contact with the base plate by use of the threads on the pivot bolt. To follow the teachings of the second embodiment would result in a system in which the work piece is not pressed against the base plate.

Consideration of the other two references cited against claim 1 does not alleviate the shortcomings in Maley and Andrew. Allen discloses a system in which index pins are provided for aligning the work piece on the base plate prior to actuating a set of clamps, and Woodman discloses cams operated by handles. Incorporation of these features into the Maley device still would not meet all the terms of claim 1. The same can be said for the Boggs and Cardner references cited against dependent claims.

Appeal No. 98-0005  
Application No. 08/613,808

It therefore is our opinion that the teachings of the prior art relied upon fail to establish a *prima facie* case of obviousness with respect to the subject matter recited in independent claim 1. This being the case, we will not sustain the rejection of claim 1 or, it follows, of any of the dependent claims.

The decision of the examiner is reversed.

**REVERSED**

	JAMES M. MEISTER	)	
	Administrative Patent Judge)	)	
		)	
		)	
	NEAL E. ABRAMS	)	BOARD OF
PATENT	Administrative Patent Judge)	)	APPEALS AND
		)	INTERFERENCES
		)	
	JEFFREY V. NASE	)	
	Administrative Patent Judge)	)	



Appeal No. 98-0005  
Application No. 08/613,808

John R. Duncan  
4565 Ruffner Street  
Suite 200  
San Diego, CA 92111